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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,560	12/27/2006	Dino Lombino	292626US0PCT	8887
22850	7590	04/02/2009		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
GRAY, JILL M				
ART UNIT		PAPER NUMBER		
1794				
NOTIFICATION DATE		DELIVERY MODE		
04/02/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/583,560

Applicant(s)

LOMBINO ET AL.

Examiner

Jill Gray

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☒ Claim(s) 5-25 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/55/08)
Paper No(s)/Mail Date 09/19/2008
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The prior art references disclosed in the specification have been considered only to the extent that they have been made available to the examiner.

Specification

2. The use of the trademarks such as "VINAMIL" has been noted in this application. They should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Objections

3. Claims 5-25 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from another multiple dependent claim. This includes claims that are singularly dependent upon an improper multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 3 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

More specifically, in claim 3 the phrases "polycarboxylic acid(s)", "anhydride(s)" and "polyol(s)" are indefinite because the use of parenthetical expressions add ambiguity to the claim and renders it difficult to determine the metes and bounds for which patent protection is being sought. If applicants' intent is for the polyester to be formed from reaction of one or more polycarboxylic acids and/or anhydrides and one or more polyol, the suggested language is "one or more" or "at least one", or similar language providing that the present specification contain clear support for said language.

6. Regarding claim 4, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Temple et al., 5,640,255 (Temple) or Schell 5,824,413.

Temple discloses a glass strand coated with an aqueous sizing composition comprising, as film forming agents, further disclosing that suitable film formers can be polyesters, polyurethanes, vinyl polymers, and mixtures thereof. See entire document, and for example, abstract, column 15, lines 39-43, and column 24, lines 18-45. In

addition, Temple discloses that the vinyl polymer can be commercially available polyvinyl acetate. Note column 17, lines 56-60.

Accordingly, the teachings of Temple anticipate the invention as claimed in present claim 1.

Schell discloses glass strands coated with an aqueous coating composition comprising a polyurethane. See entire document, and for example, abstract, column 2, lines 65-67 and column 4, lines 56 through column 5, and line 3. In addition, Schell discloses that additional film forming polymers can be present such as polyester or vinyl polymers, and mixtures thereof, wherein the vinyl polymers can be polyvinyl acetate. See column 8, lines 25-33 and column 9, lines 43-47.

Therefore, the teachings of Schell anticipate the invention as claimed in present claim 1.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
11. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Temple et al., 5,640,255 (Temple) or Schell 5,824,413, each as applied above to claim 1 and each in view of Gonthier et al., 2004/0265586 A1 (Gonthier).

Temple and Schell are as applied above but do not teach the specific formation of the polyester polymer or the molecular weight.

Gonthier teaches glass strands coated with an essentially aqueous sizing composition which comprises a polyurethane and a polyester. See entire document and for example, abstract. In addition, Gonthier teaches that his polyester is produced by the reaction of a carboxylic acid and/or anhydride and a polyol, as required by present claim 3. The polyol can be a polyalkylene glycol and the anhydride can be maleic anhydride, as required by present claim 4. See [0028]. Gonthier is silent as to the specific molecular weight of his polyester.

Temple, Schell and Gonthier are each drawn to glass strands coated with aqueous sizing compositions, wherein said compositions comprise polyurethane and polyester film forming polymers. Thus, Temple, Schell and Gonthier are in the same field of endeavor and thus are analogous art.

Regarding claims 3 and 4, it would have been obvious to one having ordinary skill in the art to use as the polyester of Temple or Schell a polyester that is produced by the reaction product of a carboxylic acid or anhydride with a polyol, essentially as claimed and as taught by Gonthier. The motivation for doing so, at the time the invention was made, is that it has been held that the combination of two known compositions each of which is taught by the prior art to be used for the same purpose to form a third composition that is to be used for the very same purpose may be *prima facie* obvious. MPEP 2144.06.

Regarding claim 2, drawn to the molecular weight range of the polyester, it is the position of the examiner that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 105 USPQ 233 (CCPA 1955).

Therefore, the combined teachings of Temple and Gonthier or Schell and Gonthier would have rendered obvious the invention as claimed in present claims 2-4.

No claims are allowed.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTOL-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill Gray whose telephone number is 571-272-1524. The examiner can normally be reached on M-Th and alternate Fridays 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on 571-272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jill Gray/
Primary Examiner
Art Unit 1794

jmg